

PATENT

Serial No. 09/158,549

Atty. Dkt. No. SEDN/5515

REMARKS

This response is intended as a full and complete response to the final Office Action mailed July 28, 2005. In the Office Action, the Examiner notes that claims 1-6, 16-21 and 41-44 are pending and rejected. By this response, claims 1, 4, 5, 16, 19, and 44 have been amended; claims 3, 18, and 41-42 have been cancelled; and claim 45 has been added.

In view of both the amendments presented above and the following discussion, Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103.

It is to be understood that Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

Amendments to the Claims, and the New Claim

By this response, claims 1, 4, 5, 16, 19, and 44 have been amended; claims 3, 18, and 41-42 have been cancelled; and claim 45 has been added.

The amended claims 1, 4, 5, 16, 19, and 44, as well as unamended claims 2, 6, 17, 20-21 and 43, are fully supported by the Specification, Drawings and Claims as originally filed in U.S. Patent Application No. 07/991,074, from which the present application claims priority. For example, these claims are supported at least by pages 54-58 of the 07/991,074 parent application.

Claim 45 is supported by the Specification, Drawings and Claims as originally filed in U.S. Patent No. 5,990,927 (Application No. 08/160,194), from which the present application also claims priority. For example, new claim 45 is supported at least by columns 26-28 and Figures 9b and 12a of U.S. Patent No. 5,990,927.

Thus, no new matter has been added, and the Examiner is respectfully requested to enter the amendments to the claims, as well as the new claim.

35 U.S.C. §103 Rejection of Claims 1-6, 16-21 and 41-44

The Examiner has rejected claims 1-6, 16-21 and 41-44 under 35 U.S.C. §103(a) as being unpatentable over Florin (U.S. Patent No. 5,621,456, hereinafter "Florin"), in

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view of Handelman (U.S. Patent No. 5,715,315, hereinafter "Handelman") and Lett (U.S. Patent No. 5,657,414, hereinafter "Lett") and further in view of Hedger (Broadcast Telesoftware: Experience ORACLE, hereinafter "Hedger"). Applicants respectfully traverse the rejection.

The present application is a divisional of U.S. Patent No. 5,990,927 (Application No. 08/160,194), filed December 2, 1993, which is a continuation-in-part of U.S. Patent Application No. 07/991,074, filed December 9, 1992. The limitations of claim 1, as amended, are fully supported by the disclosure of the 07/991,074 parent application, and thus have a priority date of December 9, 1992.

Therefore, neither the Florin reference, filed June 22, 1993, nor the Handelman reference, having a priority date of September 15, 1993, are prior art against claim 1, because these references have priority dates after the priority date of claim 1. Thus, the rejection becomes a 35 USC 103(a) rejection over the Lett reference in view of the Hedger reference.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. The Lett and Hedger references fail to teach or suggest all of the limitations recited in claim 1, and thus fail to teach or suggest the Applicants' invention as a whole.

Specifically, the Lett and Hedger references do not teach or suggest at least the hardware upgrade having the "microprocessor connected to said interface for processing the electronic mail to produce processed electronic mail".

The Lett reference discloses a subscriber terminal and, regarding an expansion card for the subscriber terminal (emphasis added below):

"The expansion card 138 is a printed circuit card which contains memory and/or secure microprocessor components, which can be plugged into a connector 200. The connector 200 electrically extends the control microprocessor memory bus 141 and the secure microprocessor bus 143 to the expansion card 138. Additional program or data memory, or renewed security can be provided by the expansion card 138." (column 8, lines 55-62)

However, the Lett reference does not disclose that the expansion card microprocessor is for processing electronic mail.

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The Hedger reference discloses a teletext decoder which can be transformed into a home computer system capable of receiving software from teletext transmissions. However, the Hedger reference does not teach or suggest at least the hardware upgrade having the "microprocessor connected to said interface for processing the electronic mail to produce processed electronic mail".

Thus, the Lett and Hedger references fail to teach or suggest the Applicants' invention as a whole.

As such, Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claim 16 has relevant limitations that are similar to those discussed above in regards to claim 1. Therefore, independent claim 16 is also not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 2, 4-6, 17, 19-21 and 42-44 depend, either directly or indirectly, from independent claims 1 and 16 and recite additional limitations thereof. As such, Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Claims 3, 18, and 41-42 have been cancelled. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

New Claim 45

New claim 45 is patentable at least because none of the cited references teach all of the limitations of the claim, including at least a hardware upgrade having "a modem for accessing an online service outside of the television program delivery system and for receiving electronic mail from the online service", "a memory for storing (i) programming instructions that enable a subscriber to engage in textual interactivity with processing of the electronic mail, and (ii) a mailbox for the transferred and processed electronic mail;" and "a microprocessor for processing the electronic mail based on the programming instructions and the textual interactivity, the microprocessor of the hardware upgrade capable of communicating with the microprocessor of the set top terminal through an interface".

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CONCLUSION

Thus, Applicants submit that none of the claims presently in the application are obvious under the provisions of 35 U.S.C. §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Stephen Guzzi at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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